

## REMARKS

The last Office Action of June 21, 2006 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-23 are pending in the application. Claims 1-13 have been canceled. Claims 14, 15, 16, 19, 22 have been amended. No claim has been added. An amendment to the specification has been made. No fee is due.

It is noted that claims 1-13, 15, 16 and 19-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 9, 11 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Pat. No. 11-138597 (hereinafter "JP '597").

Claims 4-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP '597 in view of U.S. Pat. No. 5,540,495 to Pickel or European Pat. No. EP 1,162,053 (hereinafter EP '053").

Claims 10, 13-15, 22 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP '597 in view of U.S. Pat. No. 5,580,585 to Holzschuh.

Claim 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over JP '597 in view of Holzschuh, and further in view of U.S. Pat. No. 5,773,050 to Wohlrab or U.S. Pat. No. 5,261,810 to Kamp et al.

Claim 17-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP '597 in view of Holzschuh, and further in view of either Pickel or EP '053.

## REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Applicant has canceled original claims 1 to 13, and amended claims 15, 16, 19, 22 to address the §112, 2<sup>nd</sup> paragraph rejection. These amendments are

self-explanatory and cosmetic in nature and do not narrow the claim limitations to trigger prosecution history estoppel.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is thus respectfully requested.

#### **REJECTION OF CLAIMS 1-3, 9, 11 12 UNDER 35 U.S.C. §102(b)**

The rejection under 35 U.S.C. 102(b) becomes moot as a result of the cancellation of claims 1-13.

Withdrawal of the rejection under 35 U.S.C. §102(b) is thus respectfully requested.

#### **REJECTION UNDER 35 U.S.C. §103(a)**

Applicant respectfully disagrees with the Examiner's rejection of sole independent claim 14 for the following reasons:

Claim 14 has been amended to expressly set forth that a single hydraulic pressure source is involved here for connection to the hydraulic piston and cylinder unit of the injection unit as well as to the mold clamping unit. In this way, the pressure source can be used not only for providing the hydraulic force assist for the plasticizing screw but also for operation of the clamping unit. The amendments to claim 14 are cosmetic in nature and do not narrow the claim to trigger prosecution history estoppel. Please note that original claim 14 has already recited the provision of a pressure source which is connected to the hydraulic piston and cylinder unit and to the mold clamping unit. The additions to claim 14 are merely submitted to set forth expressly what is set forth implicitly.

The Examiner's attention is also drawn to paragraph [0011] of the instant specification which outlines the advantages of the dual use of the pressure source for operating two particular components of the injection molding machine, namely the plasticizing unit and the clamping unit. The inventors of the present invention

recognized that since these particular components become operative at different times in the overall process, there is a possibility to use the pressure source for the hydraulic force assist to assist in addition the application of a clamping force. While this approach may be simple, simplicity in it of itself is not a proper criterion for resolving the issue of obviousness. (cf. *Ryan v. Goodwin*, 21 F. Cas. 110, 111 (No. 12,186) (C.C. D.Mass. 1839) "It is certainly not necessary, that every ingredient, or, indeed, that any one ingredient used by the patentee in his invention, should be new or unused before for the purpose of making matches. The true question is, whether the combination of materials by the patentee is substantially new. Each of these ingredients may have been in the most extensive and common use, and some of them may have been used for matches, or combined with other materials for other purposes. But if they have never been combined together in the manner stated in the patent, but the combination is new, then, I take it, the invention of the combination is patentable. The combination is apparently very simple; but the simplicity of an invention, so far from being an objection to it, may constitute its great excellence and value. Indeed, to produce a great result by very simple means, before unknown or unthought of, is not unfrequently the peculiar characteristic of the very highest class of minds.")

The JP '597 reference discloses a drive mechanism for an injection molding machine. The drive mechanism includes a servo motor 20 for rotating the plasticizing screw and a combination of an electric component 2, which includes a servo motor 3, and a hydraulic component 4, for moving a plasticizing screw in axial direction. JP '597 is involved exclusively with the operation of the plasticizing screw and in particular with the structure of the drive mechanism for the plasticizing screw. Applicant has downloaded a computer translation of JP '597 from the website of the Japanese Patent Office, of which a copy is enclosed for the benefit of the Examiner. No reference to a clamping unit can be ascertained from the disclosure.

The Holzschuh reference discloses a hydraulic operation system for an injection molding machine. Col. 3, lines 29-32 of Holzschuh is relevant and duplicated here for the benefit of the Examiner:

The drive components 1, 2, 3a, 3b, 4, 5 and 6 are **all** formed as hydraulic drives and are connected to a hydraulic line network by respective directional control valves 7, 8, 9, 10, 11 and 12.  
(emphasis added)

This passage makes it clear that the Holzschuh's disclosure is expressly involved exclusively with a **hydraulic** drive mechanism for an injection molding machine. The Examiner based his rejection on the disclosure in Holzschuh of an electric motor 15 for driving a pump. The mere disclosure of this combination of a pump and electric motor is however not the standard to present a *prima facie* case for obviousness unless the prior art suggests the desirability of the modification (cf. In re Gordon, 733 F.2d at 902).

JP '597, as noted above, discloses a drive mechanism for moving the plasticizing screw in axial direction by using a combination of an electric drive and a hydraulic drive. No disclosure of a clamping unit is found in JP '597. Holzschuh discloses a purely hydraulic drive assembly to operate the various components of the injection molding machine, including a mold clamping unit. In contrast to JP '593 and Holzschuh, the present invention discloses an electric drive system with the use of a single hydraulic pressure source for operating a hydraulic system (hydraulic piston and cylinder unit) as well as for assisting in the application of a clamping force. The Examiner failed to set forth how the JP '597 and Holzschuh references can be modified to produce the present invention, without contradicting the disclosure of the references and without "finding as to specific understanding or principle within knowledge of skilled artisan that would have motivated one with no knowledge of invention at issue to make combination in manner claimed." In re Kotzab, 55 USPQ2d 1313.

It is well established that the mere fact that individual elements of the present invention can be found in the prior art is not determinative as to the

question of obviousness. As stated by the Federal Circuit in *In re Rouffet*, 47 USPQ2d, 1453, 1457 "Most, if not all, inventions are combinations and mostly of old element. Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability."

Thus, there must be some motivation to combine the references to create the case of obviousness, and a showing that a skilled artisan, confronted with the problems as the inventor, would select the elements from the cited prior art references.

It is applicant's contention, that the Examiner failed to make a prima facie case of obviousness and failed to explain the motivation one with no knowledge of applicant's invention would have to combine the references in a manner suggested.

For the reasons set forth above, it is applicant's contention that neither JP '597 nor Holzschuh, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 14.

As for the rejection of the retained dependent claims, these claims depend on claim 14, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Withdrawal of the rejection under 35 U.S.C. §103(a) and allowance of claims 14-23 are thus respectfully requested.

## **CLARIFICATION AMENDMENT**

Applicant has amended the instant specification to correct obvious typographic errors. These changes are self-explanatory and do not contain new matter.

## **CITED REFERENCES**

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the claims on file. It is thus felt that no specific discussion thereof is necessary.

## **PRIORITY DOCUMENT**

Applicant further submits a certified copy of the priority document under 35 U.S.C. §119(a)-(d).

## **CONCLUSION**

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses, taken alone or in any combination an electric drive system with the use of a single hydraulic pressure source for operating a hydraulic system (hydraulic piston and cylinder unit) as well as for assisting in the application of a clamping force.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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